



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/847,632 | 05/02/2001 | Ulrich Sander | LAGP:102_US_ | 6611 |

7590 07/30/2004
Hodgson Russ LLP
Intellectual Property Law Group
One M&T Plaza
Suite 2000
Buffalo, NY 14203-2391

EXAMINER

NGUYEN, THONG Q

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2872

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/847,632 | Applicant(s) SANDER, ULRICH | |
| | Examiner Thong Q Nguyen | Art Unit 2872 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendment filed on 5/24/2004. It is noted that in the mentioned amendment, applicant has canceled claims 1-8 and 10-15, amended claim 9 and simultaneously added new claim 16 into the application. As a result of the enter of the amendment, the pending claims are claims 9 and 16.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Geschwentner (U.S. Patent No. 6,011,647, of record).

Geschwentner discloses a microscope having an illuminating system and an observation system. The illuminating system as described in column 3 and shown in figures 1 and 2 comprises a light source system (1), a further light source (22), a collector lens system (2), a diaphragm (3), a further lens element (5) and a deflecting element having a mirrored surface (6). It is noted that the collector lens system and the further light source (22) are supported by a slider (21). The movement of the slider will alternatively insert either the collector lens system (2) into the light path or the further light source (22) into the system. It is noted that when the light source (22) is in the system then the light source (1) is turned off. See column 3, lines 45-55. The arrangement of the light source (22)

when the collector lens system (2) is removed from the system or the light path of the light source (1) will reduce the light intensity of light coming to an object. The observation system comprises a main objective lens (7). The light passing through the collector lens system or the light from the further light source will pass through other optical elements of the system before it is guided through the main objective lens (7).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Geschwentner.

The microscope having an illuminating system and an observation system wherein a collector lens assembly and a further light source supported by a slider wherein either the lens system or the further light source is used for illuminating an object with different illumination pattern and thus for reducing light intensity of light on an object as provided by Geschwentner meets all of the features relating to the optical components claimed in claim 16. The only thing missing from the art of Geschwentner is that he does not explicitly state a method for adjusting the position of the illuminating light on the object. However, it would have been obvious to one skilled in the art at the time the invention was made to utilize the microscope provided by Geschwentner by setting forth a set of steps including the step of moving the module and/or pivoting the second mirror located inside

Art Unit: 2872

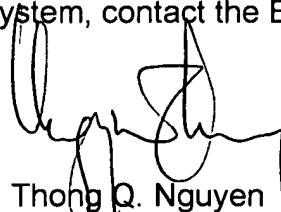
the module for the purpose of adjusting the position of the focus point on the object and thus making one area of the object in a field of view become darken or brighten.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen
Primary Examiner
Art Unit 2872
